

RESTRICTION

Claims 1-38 are pending in the application. Claims 1-38 are subject to a restriction or election requirement.

The Examiner asserted that the application contains claims directed to the following patentably distinct species of the claimed invention: (1) the species wherein the light interacts with a novolak resin proximate the substrate to produce a photoresist pattern, (2) the species wherein the light catalyzes the synthesis of a nucleotide base proximate the substrate, (3) the species wherein the light catalyzes the synthesis of an amino acid residue proximate the substrate, (4) the species wherein the light catalyzes a reaction involving a molecule proximate the substrate, and (5) the species wherein the light crosslinks a molecule proximate the substrate.

In addition, the Examiner required election of one of the following species:

- (a) the species wherein the light source is a UV light, and
- (b) the species wherein the light source produces visible light.

The Examiner stated that Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable, where claims 1, 15 and 28 are generic.

ELECTION

Applicant provisionally elects with traverse species (1) wherein the light interacts with a novolak resin proximate the substrate to produce a photoresist pattern; and further provisionally elects with traverse species (a) wherein the light source is a UV light, for

prosecution on the merits. Applicant respectfully believes that claims 1, 2-8, 13-16, 19-21, 26-34 read on the elected species.

Upon the allowance of a generic claim, Applicant will be entitled to, and respectfully requests, consideration of claims to additional species which are written in dependent for or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. 1.141.

TRAVERSE

see 806.04(f)

Every requirement to restrict has two aspects, (1) the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are either independent or distinct, and (2) the reasons for insisting upon restriction therebetween. MPEP § 808. [Emphasis in the original].

With regard to the first aspect, the Examiner failed to provide a reason as to why the species identified in the Official Action are distinct.

With regard to the second aspect, the reasons under MPEP § 808 given by the Examiner for insisting upon exercising his authority under 35 U.S.C. § 121 to require restriction must be reasons approved by the Commissioner. The reasons approved by the Commissioner are set out in MPEP § 803: (1) the inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct-as-claimed (see MPEP § 806.05 = § 806.05(i); and (2) there must be a serious burden on the examiner if restriction is not required (see MPEP § 803.02, § 806.04(a)-(j), § 808.01(a) and § 808.02). Examiner must provide reasons and/or examples to support conclusions. MPEP § 803.

X For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant. MPEP § 803.

Applicant respectfully asserts that the Examiner has failed to make a *prima facie* case that restriction is required. The Official Action to which this reply is responsive provides no reason as to why the species of the invention as claimed are either independent or distinct. The Action merely provides a conclusion that such is the case. Further, the Examiner provides no reason for insisting upon restriction between the species of the invention.

X The Action failed to establish that a serious burden would be imposed on the Examiner if restriction were not required. In particular, the Examiner failed to explain whether there is a separate classification of the separate species. The Examiner failed to establish that separate fields of searching would be required. That is, the Examiner failed to establish that, even if the distinct species may be classified in the same class or subclass, a complete search would require examination of other classes and subclasses that differ for each distinct species, thereby imposing a burden on the Examiner if all the inventions were examined in the same application. Finally, X the Examiner failed to establish that the distinct species have achieved a separate status in the art, even though they are classified together. MPEP § 803. These are the only explanations approved by the Commissioner to show that a serious burden would be imposed on the Examiner in the absence of the restriction requirement. Applicant respectfully asserts that the *prima facie* requirements of MPEP § 803 were not met in the Official Action.

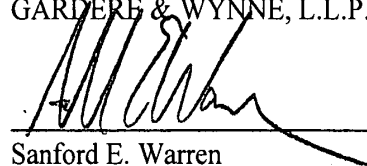
Therefore, Applicant respectfully urges that the requirement for restriction/election is improper. Applicant respectfully requests reconsideration and withdrawal of the restriction/election requirement.

CONCLUSION

Applicant provisionally elects species (1)(a) with traverse. For the reasons set forth above, Applicant respectfully requests reconsideration by the Examiner and withdrawal of the restriction/election requirement. Applicant amended claim 1 to correct a typographical defect. Applicant submits that claims 1-38, as amended, are fully patentable. Favorable consideration and allowance of the application is therefore respectfully requested. If the Examiner has any questions or comments, or if further clarification is required, it is requested that the Examiner contact the undersigned at the telephone number listed below.

Dated: June 23, 2000.

Respectfully submitted,
GARDERE & WYNNE, L.L.P.



Sanford E. Warren
Registration No. 33,219

ATTORNEYS FOR APPLICANTS
Gardere & Wynne, L.L.P.
3000 Thanksgiving Tower
1601 Elm Street
Dallas, Texas 75201-4761
(214) 999-4339 - Telephone
(214) 999-3339 - Facsimile